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OFFICE OF PETITIONS

In re Application of	:	
Caplan, et al.	:	
Application No.: 10/697,907	:	DECISION REFUSING STATUS
Filed: October 29, 2003	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: ISAA0025	:	
For: METHOD AND APPARATUS FOR	:	
CREATING AND EVALUATING STRATEGIES	:	

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed August 23, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on October 29, 2003 without an executed oath or declaration. Accordingly, on January 30, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for their late filing.

In response, on April 30, 2004, a petition for a one month extension of time and required fee, a declaration executed by 11 of 15 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A statement of facts by Rhonda Dunn, the patent administrator for the non-signers' former employee, accompanies the petition. Ms. Dunn explains that non-signing joint inventor Gary Sullivan received multiple copies of the above-identified application and declaration for the above-identified application, but he did not respond to the many requests that he sign the declaration for patent application. The statement of facts of Attorney Michael A. Glenn and accompanying exhibits establish that the three other non-signing inventors, John Perlis, Nina Shikaloff, and Aush Thaker, refused to review the declaration and application papers, let alone sign the declaration, unless certain demands were met. Their attorney, William M. Scherer, returned the unread application papers and declaration on his clients' behalf. The evidence presented shows that the inventors were given the opportunity to review the application papers, but declined to do so. They have constructively refused to join in the filing of the application.

Applicants' petition was dismissed on June 2, 2004 because the declaration did not contain identifying information for all inventors and a complete statement of the last known address for the non-signing inventors was not provided.

The instant reconsideration petition was timely filed on August 23, 2004.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (2) and (4) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration is not acceptable because it does not include all identifying information for Inventors Perlis and Thaker. The citizenship of each inventor must be included on the oath or declaration. It is noted that the declarations filed on October 29, 2003 and April 30, 2004 listed the citizenship of Inventors Perlis and Thaker. The latest declaration deletes this information. As listing the citizenship for each inventor is a statutory requirement under 35 U.S.C. § 115, it cannot be waived. If citizenship for the non-signing inventors has not been definitively ascertained petitioners' best information with respect to citizenship should be used.

Information for Inventor Perlis is still absent from the declaration. Since petitioners are in contact with Inventor Perlis' attorney, it is assumed that Inventor Perlis' address could be obtained from his attorney. If not, petitioners should at least attempt to ascertain his address by searching the Internet. It is assumed he resides in the Bay Area.

As stated in the previous decision: Information for all inventors must be listed on a new declaration. This information includes: Given Name(s), Family Name, Citizenship, Residence, and Mailing Address. 37 CFR 1.63(a) (2)-(3) and 37 CFR 1.63(c)(1) **The available inventors must execute this new declaration on behalf of the non-signing inventors.** The non-signing inventors signature blocks should be left blank.

As to item (4), a clear statement of Inventor Perlis' last known address is still missing and is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

A handwritten signature in black ink, appearing to read "E. Shirene Willis". The signature is fluid and cursive, with a large initial "E" and a stylized "W".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy